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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/606,504	06/26/2003	James P. Peterson	200920-9007	5220
1131 7590 07/24/2008 MICHAEL BEST & FRIEDRICH LLP Two Prudential Plaza 180 North Stetson Avenue, Suite 2000 CHICAGO, IL 60601				
EXAMINER				
SHEWAREGED, BETTELHEIM				
ART UNIT		PAPER NUMBER		
1794				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/606,504

**Applicant(s)**

PETERSON, JAMES P.

**Examiner**

Betelhem Shewareged

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2008.  
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 35 and 38-55 is/are pending in the application.  
4a) Of the above claim(s) 35 and 47-55 is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 38-46 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Applicant's response along with the Declaration Under 37 CFR 1.132 filed on 04/01/2008 has been fully considered. Claims 1-34, 36 and 37 are canceled, claim 38 is amended, and claims 35 and 38-55 are pending. Currently, claims 35 and 47-55 are withdrawn from consideration as non-elected invention.

### ***Claim Rejections – 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2. Claims 38-40, 42 and 44-46 are rejected under 35 U.S.C. 102(a) as being anticipated by Mosher, Jr. et al. (US 5,979,941).
3. Mosher teaches a card/badge comprising a plastic substrate (col. 3, lines 41-47), coating the substrate with an adhesive, and covering the substrate with a paper cover (col. 3, lines 60-64). In one embodiment, the substrate is being scored to form a scroelines in order to form segments such as card/badge, wristband and so on so as to selectively remove the segment (card/badge) along with the adhesive from the paper cover (col. 3, line 65 thru col. 4, line 2), and it can be adhered to the clothing of the individual utilizing the card/badge (col. 4, lines 2-4). Mosher further teaches that information is being printed on the card (segment) using a printer (col. 6, lines 9-10). Since Mosher teaches printing the card with the printer, it is understood that Mosher

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uses a card printer, and the cut card must be fed to the printer. If it is the applicant's position that this would not be the case: (1) evidence would need to be provided to support the applicant's position; and (2) it would be the Office's position that the application contains inadequate disclosure that there is no teaching as to how to obtain the claimed properties with only the claimed ingredients.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mosher, Jr. et al. (US 5,979,941) as applied to claim 38 above, and further in view of Wessel (US 4,583,766).

6. Mosher teaches the badge along with the method of making as set forth above. Mosher does not teach the use of polyvinylchloride (PVC) as the substrate. However, Wessel teaches the use of PVC to make a badge (abstract). Mosher and Wessel are combinable because they are from the same field of endeavor namely badge and method of making. At the time of the invention it would have been obvious to a person of ordinary skill in the art to combine the PVC of Wessel with the invention of Mosher, and the motivation would be to reduce cost and enhance printing quality.

7. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mosher, Jr. et al. (US 5,979,941) as applied to claim 38 above.
8. Mosher teaches the claimed invention except for slots or holes in the card/badge. It would have been obvious matter of design choice to make slots or holes in the labels, since applicant has not disclosed that the slots and holes solves any stated problem or is for any particular purpose and it appears that the invention would perform equally well with the slots and holes.

***Response to Arguments***

9. Applicant's argument is based on that Mosher does not teach or suggest cutting only the card and not the backing. This argument is not persuasive for the following reason. Mosher expressly teaches cutting/scoring the release paper covering only for the wristband (col. 4, lines 57-65), does not teach cutting the release paper covering for the card/badge or the tickets.
10. Applicant further argued that Mosher does not teach or suggest coupling the card/badge to a finding, rather Mosher discloses adhering the card/badge to the clothing of the individual. This argument is not persuasive for the following reasons. The claimed "finding" is a target material. The target material is considered; however, it is not given patentable weight because the target material does not materially affect the structure of the claimed card having image, adhesive and removable backing; and the target material does not affect the method in a manipulative sense. Alternatively, even though the target material of Mosher is clothing, the claimed card is capable of being

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adhered to a cloth. Current specification teaches a pin back, an alligator clip and a jump ring as examples of finding, and the finding of the current invention is not limited to the above three examples. The current specification does not expressly exclude cloth as finding. Since the claimed card can be attached to a cloth (page 10, line 13) the cloth could be considered as the claimed finding.

11. Applicant also argued that the Examiner fails to consider claim terms such as "card" and "card printer", and also provided a declaration under 37 CFR 1.132 to show that the cited references of Mosher and Wessel do not teach or suggest "card" and "card printer". This argument is not persuasive for the following reason. The reference of Mosher expressly teaches "card" (*see at least* col. 3, line 66). In the declaration, inventor Peterson expressly discloses that card printers are designed to receive cards (*see* page 2, paragraph 6). Mosher expressly teaches that the card is printed by "a printer" (col. 6, line 10). It can be established that the printer used in Mosher is a "card printer" because the image receiver that is fed into the printer of Mosher is a card, and also the declaration discloses the card printers are designed to receiving cards.

12. For the above reasons claims 38-46 stand rejected.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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14. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is (571)272-1529. The examiner can normally be reached on Monday-Friday 9am-5pm.

16. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano can be reached on 571-272-1398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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17. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

BS

July 20, 2008.

/Betelhem Shewareged/  
Primary Examiner, Art Unit 1794.